

1 REMARKS

2 Amendments to the Drawings

3 Reference numbers "118a', 118b' and 120'" are mentioned in the description but were
4 inadvertently omitted from the drawings. A formal replacement drawing for FIGURE 1B that
5 includes the reference numbers "118a', 118b', and 120'" is submitted herewith. Accordingly, the
6 objection to the drawing should be withdrawn.

7 Amendments to the Specification

8 The specification has been amended to claim priority under 35 U.S.C. § 120 in a co-pending
9 and commonly assigned application, Serial No. 09/726,058, which was filed on November 29, 2000.

10 Reference number "360" is mentioned in the description but is not included in the drawings.
11 Reference number "360" is now replaced in the specification (please see the Amendment to the
12 Specification section above) by the phrase "not shown."

13 In addition, reference number "321" is tagged to a processing unit in the drawings, but is
14 indicated as reference number "322" in the specification. Accordingly, the incorrect reference
15 number "322" has been changed in the specification to "321" to correctly designate the processing
16 unit properly, as indicated in the Amendment to the Specification section above.

17 The disclosure recites that "the method returns to step 510" in reference to FIGURE 5, but
18 FIGURE 5 shows that the method returns to step 508. The disclosure has therefore been amended to
19 recite that "the method returns to step 508." Please see the Amendment to the Specification section
20 above.

21 The disclosure also recites that "the method ends at step 516" in reference to FIGURE 5, but
22 FIGURE 5 shows that the method ends at step 518. As amended above, the disclosure now recites
23 that "the method ends at step 518." Please see the Amendment to the Specification section above.

24 The disclosure fails to properly reference step 516. The disclosure, as amended above, now
25 recites that "If another format exists, the next format is chosen ($N = N + 1$) at step 516."

26 Status of the Claims

27 Claims 1-22 remain pending in the application. Claims 1, 11, 13, 20, 21 and 22 have been
28 amended to more clearly define the present invention, and Claims 6 and 17 have been amended to
29 correct typographical errors.
30

1 Claims Rejected Under 35 U.S.C. § 101

2 The Examiner has rejected Claims 1, 3-9, 11, 21, and 22 under 35 U.S.C. § 101 as being
3 directed towards non-statutory subject matter. Claims 1, 11, 13, 20, 21, and 22 have been amended to
4 clearly indicate that the invention is directed to reformatting a previously formatted *electronic*
5 document, which cannot be done “mentally and/or using paper and pencil.” Also, Claims 1 and 21
6 have been amended to provide that the reformatting is done using a computing device – which again
7 excludes the claimed invention from being carried out mentally by a human. Accordingly, this
8 rejection of Claims 1, 3-9, 11, 21, and 22 has been fully addressed and should be withdrawn.

9 Claims Rejected Under 35 U.S.C. § 102(b) over Borland

10 The Examiner has rejected Claims 1-22 as being anticipated by Russo Borland (“Running
11 Microsoft Word 97,” published by Microsoft Press, Redmond, Washington 1997, hereinafter referred
12 to as “Borland”). The Examiner asserts that Borland teaches each element of applicants’ claimed
13 invention. Applicants respectfully disagree for the reasons discussed below.

14 In the interest of reducing the complexity of the issues for the Examiner to consider in this
15 response, the following discussion focuses on independent Claims 1, 13, and 21. The patentability of
16 each remaining dependent claim is not necessarily separately addressed in detail. However,
17 applicants’ decision not to discuss the differences between the cited art and each dependent claim
18 should not be considered as an admission that applicants concur with the Examiner’s conclusion that
19 these dependent claims are not patentable over the disclosure in the cited references. Similarly,
20 applicants’ decision not to discuss differences between the prior art and every claim element, or every
21 comment made by the Examiner, should not be considered as an admission that applicants concur
22 with the Examiner’s interpretation and assertions regarding those claims. Indeed, applicants believe
23 that all of the dependent claims patentably distinguish over the references cited. However, a specific
24 traverse of the rejection of each dependent claim is not required, since dependent claims are
25 patentable for at least the same reasons as the independent claims from which the dependent claims
26 ultimately depend.

27 With regard to independent Claim 1, applicants’ recited claim language concerning the steps
28 of receiving user-selections of a color and font set, and determining a format set based on the color
29 and font set is neither taught nor suggested by Borland. According to applicants’ specification, a
30 “format set” is defined by a “color set” and a “font set” (see applicants’ specification, page 4,

1 lines 27-28). A “color set” comprises a number of colors, that if used together, create a professional
2 looking color scheme. For example, a “grape” color set may represent various shades and hues of the
3 color purple (see applicants’ specification, page 4, line 32 – page 5, line 2). A “font set” includes a
4 number of fonts that work well within a given theme, such as a font set named “hefty” that includes
5 heavier fonts in various point sizes (see applicants’ specification, page 4, lines 27-30).

6 The Examiner asserts that Borland anticipates the step of Claim 1 of receiving user-selections
7 of a color set and a font set and cites page 42 under the Text Looks section. Page 42 instructs the
8 user in selecting a font name, style, size, and colors. First, it should be emphasized that this section
9 of the prior art refers only to selecting a *single* font name, style, and size for a selected text; it does
10 not refer to selecting a *set* of font names, font styles, and sizes. As shown in Figures 2-5 and as
11 discussed on page 43 of Borland, after the user has selected the text that is to be changed, the user
12 selects the desired font name, style, and size from an available set. Although a set is available in the
13 pull down menu, the user can only make one choice from this set and cannot select a set of fonts to be
14 applied in reformatting a document, and without limitation to only text that has been selected.
15 Second, although this section instructs the user in selecting “colors,” which implies the user may
16 select more than one color, under the Adding Color to Your Words section on page 46, step four
17 instructs a user to select the color desired from the color palette. If the user want to change the color,
18 the user must select a new color from the color palette for a specific text selection. Thus, the user can
19 never select more than a single font name, style, size, or color in a single selection, unlike applicants’
20 claimed method, which provided for receiving user-selections of both a color *set* and a font *set*.

21 The Examiner also asserts that Borland anticipates the step of Claim 1 of determining a
22 format set based on the user selection of the color set and the font set and cites to the sections entitled
23 “Adding and Removing Font Styles,” pages 42-44, and “Adding Color to Your Words,” pages 46-47.
24 However, as discussed above, since the format set comprises a color set and a font set, the format set
25 is more than a *single* font name, style, size, and color. Thus, the step of receiving user-selections of a
26 color set and a font set to determine a format set is neither taught nor suggested by Borland.

27 Applicants’ recited claim language concerning analyzing the discrete portion of text to
28 determine a text font name, color, and size is also neither taught nor suggested by Borland. A
29 “discrete portion of text” is a “continuous portion of text having a consistent format applied thereto”
30 (see applicants’ specification, page 13, lines 21-25). Thus, when the document is scanned, transitions

1 in formatting will be noted and will signify a new discrete portion of text (see applicants'
2 specification, page 13, lines 24-25). The Examiner asserts that Borland anticipates the third step of
3 Claim 1, wherein each discrete portion of text in the document is analyzed to determine a text font
4 name, color, and size and cites the "Shopping in the Style Boutique" section on pages 60-61 of the
5 cited art. This section describes how the user selects the paragraph or text to which to apply the style
6 and then chooses the Format Style command, as outlined in steps 1 and 2 on page 60. In other words,
7 the user selects a portion of text without regard to looking for transitions in format. Thus, the user
8 may select two paragraphs that contain different font sizes, and font faces and proceed to reformat the
9 selection. In contrast, in applicants' claimed method, the user does not select a paragraph or text to
10 be reformatted. Instead, once the document has been scanned, and it has been determined where
11 there exist continuous portions of text having a consistent format, the reformatting is then applied to
12 the entire continuous portion of text having a consistent format.

13 The Examiner also cites the "Flexing the Fonts" section on pages 447-450 of Borland as
14 anticipating the third step of Claim 1. But this section of the cited art describes how to stretch or
15 shrink words, and how to set letter spacing and set up decorative initial letters once the desired font
16 has been selected. In contrast, applicants' claimed method provides a logical process for determining
17 a format font name, color, and size that is different from the original font name, color, and size, but
18 which is aesthetically appealing and ensures that the integrity and proportionality of the document is
19 preserved (see applicants' specification, page 6, line 24). This claimed method also eliminates a
20 problem that lay users have because they are unable to determine the fonts that look best, the
21 appropriate sizes and color schemes to apply (see applicants specification, page 2, lines 11-13).
22 Unlike applicants' claimed invention, Borland simply manipulates text having the same font.

23 The Examiner further asserts that Auto Format options on page 41 of Borland anticipate the
24 final step of reformatting the discrete portion of text such that the format having the greatest
25 associated match quality is applied. Auto Format options employ either a user defined or selectable
26 reformatting technique that is applied to any portion of the document whereas applicants claimed
27 method reformats the document so that the document is aesthetically appealing and ensures that the
28 integrity and proportionality of the document are properly preserved. Thus, Borland does not teach
29 or suggest analyzing text and furthermore, does not teach or suggest a method by which text is
30 reformatted such that a format having the greatest associated match quality value is applied to the

1 text. Accordingly, the rejection of independent Claim 1 under 35 U.S.C. § 102(b) over Borland
2 should be withdrawn for the reasons given above.

3 Independent Claim 13 distinguishes over Borland for reasons similar to those expressed above
4 in connection with Claim 1. Accordingly, the 35 U.S.C. § 102(b) rejection of independent Claim 13
5 over Borland should be withdrawn.

6 Likewise, independent Claim 21 also distinguishes over Borland for reasons similar to those
7 expressed above in connection with Claim 1. Accordingly, the rejection of independent Claim 21
8 under 35 U.S.C. § 102(b) should be withdrawn.

9 Because dependent claims are considered to include all of the elements of the independent
10 claims from which the dependent claims ultimately depend and because Borland does not disclose or
11 suggest all of the elements of independent Claims 1, 13, and 21, the rejection of dependent
12 Claims 2-12, 14-20, and 22, under 35 U.S.C. § 102(b) over Borland should be withdrawn for at least
13 the same reasons as the rejections of Claim 1, 13, and 21.

14 In view of the Amendment and the Remarks set forth above, it will be apparent that all claims
15 in the application define a novel and nonobvious invention. Accordingly, this application should be
16 passed to issue without further delay. Should any questions remain, the Examiner is asked to
17 telephone applicants' attorney at the number listed below.

18 Respectfully submitted,

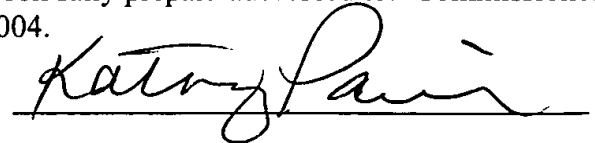
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24 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a
25 sealed envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for
26 Patents, Alexandria, VA 22313-1450, on June 4, 2004.

27 Date: June 4, 2004



28 Enclosures

29 Replacement Formal Drawing FIGURE 1B
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